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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/583,157 | 06/16/2006 | Viktor Menart | 33581-US-PCT | 5099 |
| <div>7590 04/07/2009</div> <div>Mark S. Graham, Esq. LUEDEKA, NEELY & GRAHAM, P.C. P.O. Box 1871 Knoxville, TN 37901</div> | | | | |
| <div>EXAMINER</div> <div>WOODWARD, CHERIE MICHELLE</div> | | | | |
| <div>ART UNIT</div> <div>PAPER NUMBER</div> <div>1647</div> | | | | |
| <div>MAIL DATE</div> <div>DELIVERY MODE</div> <div>04/07/2009</div> <div>PAPER</div> | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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| APPLICATION NO./ CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR / PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
|---------------------------------|-------------|---|---------------------|
| 10583157 | 6/16/2006 | MENART ET AL. | 33581-US-PCT |

EXAMINER

CHERIE M. WOODWARD

| ART UNIT | PAPER |
|----------|----------|
| 1647 | 20090402 |

DATE MAILED:

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Commissioner for Patents

The reply filed on 1/29/2009 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicant has not adequately replied to the Provisional Obviousness Type Double Patenting Rejections. Applicant argues that 35 USC 103(c) should apply and that if the examiner believes Applicants are incorrect about the application of 35 USC 103(c) to the ODP rejections and provides a convincing line of argument as to why 103(c) does not preclude the Examiner's reliance on the copending Applications, Applicants will "consider" filing terminal disclaimers (Remarks, p. 7, last paragraph to p. 8, first paragraph). Applicant's reasoning and arguments have been considered, but they are not persuasive and they do not constitute a complete and adequate response to the ODP rejections. First, 35 USC 103(c) is not applicable to double patenting situations, as it applies to rejections made under 102(e), (f), and (g), made pursuant to research agreements (see 35 USC 103(c)(1)). Applicant is specifically referred to MPEP 804 and its lengthy discussions regarding double patenting rejections. Applicant is strongly encouraged to use the flow charts provided in MPEP 804. After reviewing MPEP 804, Applicant should recognize that all Applications owned by the same assignee or having one inventor in common are subject to various double patenting rejections. Applicant is also referred to In re Baselle Poliolefine Italia, 2007-1450, slip op. at 13 (Fed. Cir. 13 Nov 2008), holding that the examiner does not have to provide a 103-type Graham analysis in an obviousness-type double patenting rejection. Additionally, Applicant's statement that they will "consider" filing a terminal disclaimer at some future time if certain events occur is not a proper response and is tantamount to a request to hold the rejections in abeyance. A request to hold a rejection in abeyance is not a proper response to a rejection. Rather, a request to hold a matter in abeyance may only be made in response to an objection or requirements as to form (see MPEP 37 CFR 1.111(b) and 714.02).

As such, the submission filed 1/29/2009 is not fully responsive because it is not in compliance with 37 CFR 1.111(b), which states that "[i]n order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

Since the above-mentioned reply appears to be bona fide, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cherie M. Woodward whose telephone number is (571) 272-3329. The examiner can normally be reached on Monday - Friday 9:30am-6:00pm (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath N. Rao can be reached on (571) 272-0939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cherie M. Woodward/
Primary Examiner, Art Unit 1647